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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,165	09/11/2003	Ravinder S. Dhallan	543312000420	7501
25226	7590	11/01/2005	EXAMINER	
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			WHISENANT, ETHAN C	
		ART UNIT	PAPER NUMBER	
		1634		

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/661,165	DHALLAN, RAVINDER S.
	Examiner Ethan Whisenant, Ph.D.	Art Unit 1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 May 2005.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-180 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-180 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**ELECTION / RESTRICTION**

1. The applicant's Preliminary Amendment filed 23 MAY 05 has been entered. Following the entry of the Preliminary Amendment, **Claim(s) 1-180** is/are pending.

**SEQUENCE RULES**

2. This application complies with the sequence rules and the sequences have been entered by the Scientific and Technical Information Center.

**ELECTION/RESTRICTION**

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. **Claims 1-152, and 156-180** drawn to a method and kit for detecting a chromosomal abnormality, classified in Class 435, subclass 6.

II. **Claims 153-154**, drawn to a composition comprising fetal DNA and maternal DNA, classified in Class 536, subclass 23.1 and 24.3.

III. **Claim 155**, drawn to a method of analyzing a composition comprising fetal DNA and maternal DNA, classified in Class 435, subclass 6.

4. The inventions are distinct, each from the other for the following reasons.

**Inventions I and II** are related as a process and a product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process can be practiced on a sample comprising 100.00% fetal DNA or 100.00% maternal DNA or 100.00% paternal DNA.

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**Inventions I and III** are unrelated and patentably distinct methods with different goals, different intermediate steps and different end results (see MPEP § 806.04, MPEP § 808.01).

**Inventions II and III** are related as a process of use and a product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process can be practiced on a sample comprising 100.00% fetal DNA or 100.00% maternal DNA or 100.00% paternal DNA.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the necessity for non-coextensive literature searches, restriction for examination purposes as indicated is proper.

6. The examiner attempted but failed, on 25 OCT 05, to obtain an election to the above restriction requirement via telephone. The applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### CONCLUSION

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached at (571) 272-0745.

The Central Fax number for the USPTO is (571) 273-8300. Before faxing any papers, please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).



**ETHAN WHISENANT  
PRIMARY EXAMINER**

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